

Application No.: 10/625,391
Date of Amendment: 10/05/2005
Date of Office Action: 04/05/2005

REMARKS

The Detailed Action requires a separate filing of an Information Disclosure Statement listing all references included in the specification. An IDS is submitted herewith.

Claims 37-40, New Matter Rejection:

Claims 37-40 were rejected under 35 USC 251 as being based on new matter added to the patent for which reissue is sought. The examiner states that a screen "jacket" is not taught by the original application. The word "jacket" does not appear in the specification and so has been removed from the amended Claims 37-40, although introduction of the term "jacket" was not intended to teach previously untaught matter.

Claims 22-26, 28-44 and 46-54, Recapture Rejection:

Claims 22-26, 28-44 and 46-54 were rejected under 35 USC 251 as improperly attempting to recapture previously surrendered subject matter. The examiner correctly notes that these claims omit the limitation that the screen be "pleated" or "circumferentially pleated," when compared to the independent claims in the patent.

Applicant respectfully traverses the "recapture" rejection on the grounds that the Applicant did not surrender the subject matter during prosecution, by amendment, argument or otherwise. The Applicant did not argue or otherwise rely on the "pleated" or "circumferentially pleated" aspect of the claims to distinguish over the prior art. Consequently, there has been no "admission" of unpatentability and Applicant does not now seek to recapture surrendered subject matter. See *In re Clement*, 131 F.3d 1464, 1469, 45 USPQ2d 1161 (Fed. Cir. 1997) (recapture rule does not apply in the absence of evidence of "an admission that the scope of that claim was not in fact patentable."); *Hester Indus. v. Stein Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) (in determining whether there is a surrender, the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding patentability; case involving surrender by way of arguments).

The originally-filed application claims included the limitations regarding "pleated" and "circumferentially pleated" filter elements. See, Application, p.12-13 and 15 (independent Claims 1, 7 and 14), as originally filed. The "pleated" language was not added

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by amendment to overcome a prior art rejection. Further, the "pleated" language was not relied upon in traversing a rejection or to distinguish the claims over cited prior art.

Regarding apparatus claims 22-26, the examiner states that "the circumferentially pleated aspect of these claims was specifically argued" by the Applicant and cites to pages 5-6 of Applicant's response of December 6, 2000.

In the Office Action of September 12, 2000, the examiner rejected independent Claim 1 citing Swift (3,353,599), and rejected independent Claims 7 and 14 citing Whitebay (5,404,954). See, September 12, 2000 Office Action, p. 2-3. The Applicant, in its December 6, 2000 Response, amended Claim 1 regarding the subject matter of expanding the screen (and not regarding the pleated form of the screen) to distinguish over Whitebay. Applicant amended Claim 1 to require that the filter element be "radially expanded" rather than "configured for expansion." See, Response of December 6, 2000, p. 9. The Applicant argued that the "radially expanded" limitation was not taught by Whitebay: "The Whitebay et al reference discloses a pleated woven metal filter element 22 ... However, this reference does not describe expanding the filter element ..." *Id.*, p. 5. Further, after thus admitting that Whitebay "discloses a pleated woven metal filter element," it is not logical that Applicant simultaneously, as the examiner indicates, argued and relied upon the "pleated" configuration of the filter to distinguish over the prior art. Applicant did not argue during prosecution that the "pleated" nature of the filter was distinguishing, but rather that the "radially expanded" state of the filter was distinguishing. Consequently, the Applicant did not surrender coverage relating to the subject matter of the pleated/unpleated nature of the filter and does not now seek to recapture surrendered matter.

Similarly, in the September 12, 2000 Office Action, the examiner indicated that Swift taught the limitations of independent Claims 7 and 14, each of which, as originally drafted, included a limitation requiring a "circumferentially pleated" filter element. See, September 12, 2000 Office Action, p. 2-3; App. at Claims, p.13 and 15. In its December 6, 2000 Response, the Applicant amended both Claims 7 and 14 to require the filter element be made of "woven metal material." See, December 6, 2000 Resp., at p. 9-10. The Applicant relied on this subject matter – the "woven metal material" nature of the screen – and, as with Claim 1, the "expanded" nature of the filter to distinguish over Swift: "The Swift structure does not utilize an expandable pleated filter structure, let alone a pleated filter structure made of a

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woven metal material ..." *Id.*, p. 6 (emphasis added). Applicant further clarified its remarks: "[I]t should be noted that the structures 54 shown in FIG. 5 of Swift are not filtering structures, but are epoxy-filled sealing structures ... [T]he Swift structure is devoid of a filter element, pleated or otherwise ..." *Id.*, pp. 6-7 (emphasis added). The Applicant did not rely on the "pleated" nature of the filter to distinguish over the prior art; nor are Applicant's statements specific as to the "pleated" limitation. Section 1412.02 of the Manual of Patent Examining Procedure (MPEP) provides that where a limitation of the patent claims is omitted in the reissue claims, "[t]he argument that the claim limitation defined over the rejection must have been specific as to the limitation; rather than a general statement regarding the claims as a whole. A general 'boiler plate' sentence ... will not be ... sufficient to establish surrender and recapture."

Regarding process claims 28-44 and 46-54, the examiner states that "the circumferentially pleated aspect of these claims was specifically argued" by the Applicant and cites to page 6, last paragraph of Applicant's response of December 6, 2000; and page 5, paragraphs 4-6 of Applicant's response of February 2, 2001.

The arguments in Applicant's February 2, 2001 response similarly fail to provide a surrender of claim subject matter. (Applicant's December 6, 2000 response has already been discussed, see above). Here too, Applicant distinguished Swift because Swift's seal structures are not filter elements: "The screen structure shown in FIG. 5 of Swift is made up of a slotted liner 32 having ... glass-fabric mats 54. ... [T]he mats are not pleated filter elements but are impermeable seal structures. They thus do not filter fluid flowing inwardly through the Swift screen structure after its liner portion is expanded." See, February 2, 2001 Response, pp. 3-4. Regarding the Donnelly et al reference, Applicant merely quoted from the Examiner's statements (e.g., "the Examiner acknowledges that the Donnelly et al reference 'does not teach a circumferentially pleated filter element.'"), so Applicant fails to see how this could constitute any "admission" or surrender. *Id.*, p. 3. Applicant then concluded: "Thus, neither of the Donnelly et al and Swift references teaches or in any manner suggests the provision or use of a circumferentially pleated filter element as presently recited in Claims 19 and 20." *Id.*, p. 4 (emphasis added). This general "boiler plate" sentence is not sufficient to establish recapture. See MPEP § 1412.02; see also *Ex parte Yamaguchi*, 61 USPQ2d 1043, 1046-47 (Bd. Pat. App. & Int. 2001) (statement of reasons for allowance

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would not provide any surrender of claimed subject matter, even if applicant had made the statement; the statement of reasons for allowance was "simply a restatement of the entirety of claim 1 as allowed, indicat[ing] that the examiner did not attribute patentability to any one or several features recited by the claim but, rather, found that the claim as a whole distinguished over the prior art") (opinion quoting from applicants' brief).

These amendments should clarify the Applicant's invention. The Claims are believed to be allowable, and such action is respectfully requested. If the examiner is of the opinion that prosecution of this Office Action would be expedited by a telephone interview, please do not hesitate to call Peter Schroeder at 214-220-0444.

The Commissioner of Patents is hereby authorized to charge any fees or overpayments to Deposit Account No. 50-3037. A duplicate copy of this fee authorization sheet is enclosed for this purpose.

Dated: October 5, 2005

CERTIFICATE BY FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office MAIL STOP AMENDMENTS, COMMISSIONER OF PATENTS, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450 to fax number: 571-273-8300 on:

October 5, 2005

Date of Deposit

David L. Joers

Printed Name of Person Signing Certificate

David L. Joers

Signature

October 5, 2005

Date of Signature

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